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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,556	06/21/2002	Kouji Sato	Q68808	7204

23373 7590 03/22/2004
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WASHINGTON, DC 20037

EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,556

Applicant(s)

SATO ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) 17-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 98 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-98 are pending. Claims 17-97 are withdrawn from prosecution.
2. It is required that applicants delete claims 17-97 in response to this Office Action.

Response to Amendment

3. Applicant's amendment filed 2/26/2004 in response to the previous Office Action (Paper No. 6) is acknowledged. Rejection of claims 1-16 under 35 U.S.C. § 112, second paragraph (Paper No. 6, paragraph 4) has been maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 and claims dependent thereon are rejected because the phrase in Method 1 (page 13) "a liquid culture medium of microorganism, cells of this microorganism or processed cells of this microorganism" is not indefinite. Which liquid culture medium of microorganism, or cells of this microorganism are covered and which are not? Note that the

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phrase "an enzyme capable of asymmetrically hydrolyzing an ester" is acceptable, since it covers only those enzymes that are capable of asymmetrically hydrolyzing an ester. The phrase "a liquid culture medium of a microorganism, cells of this microorganisms or processes cells of this microorganism" is not acceptable, because the limitation "capable of asymmetrically hydrolyzing an ester" applies only for the enzymes, but not for "liquid culture medium of a microorganism, cells of this microorganisms or processes cells of this microorganism."

Response to arguments

Applicant's argument filed 02/26/2004 has been fully considered but it is not persuasive.

Applicants argue that the scope of the subject matter embraced by the claim is clear and that it comply with the second paragraph of § 112. The examiner disagrees with applicants. In a process of making chemical compounds, conditions such as solvents, temperature, reactants, pressure, catalysts etc. are essential for the reaction. The phrase "a liquid culture medium of microorganism, cells of this microorganism or processed cells of this microorganism" remains indefinite, since no one for sure knows the metes and bounds of the claim.

In regard to the argument "In the present case, the scope of the claimed subject matter is clear on its face. The plain meaning of the terms in Claim 1 requires that....liquid culture medium of a microorganism, cells of their

microorganism or processes cells of microorganism that is capable of asymmetrically hydrolyzing an ester be included within the scope of the present claims." The examiner disagrees with applicant's argument. Unlike the enzymes, the liquid culture medium of a microorganism, cells of this microorganism or processes cells of this microorganism are not limited to those that are capable of asymmetrically hydrolyzing an ester. It covers any liquid culture medium of a microorganism, cells of this microorganism or processes cells of this microorganism, regardless of their capability (asymmetrically hydrolyzing an ester). Thus, the claim remains indefinite. It is recommended that applicants limit the "liquid culture medium of a microorganism, cells of their microorganism or processes cells of microorganism" to those that are capable of asymmetrically hydrolyzing an ester. This can be done by inserting the phrase "capable of asymmetrically hydrolyzing an ester" after the phrase "a liquid culture medium of a microorganism, cells of their microorganism or processes cells of microorganism."

The language of claim 98 is acceptable.

Objection

5. Claim 98 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

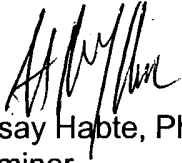
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Hapte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH
March 18, 2004